

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of: Lyons et al.
Serial No.: 10/693,845
Filed: 10/20/2003
For: PLATINUM-IMPREGNATED HYDROUS TIN OXIDE CATALYSTS
Examiner: Dove, Tracy Mae
Art Group Unit: 1745

Honorable Commissioner of Patents
PO Box 1450
Alexandria, VA 22313-1450

May 22, 2007

PETITION UNDER 37 C.F.R. § 1.181 TO WITHDRAW FINALITY OF OFFICE ACTION

Sir:

This petition is filed pursuant to 37 CFR § 1.181 and MPEP 706.07(c) and 1002.02(c)(3)(a). Applicants respectfully request that the finality of the office action of 05/13/2005 be withdrawn. Under MPEP 1002.02(c)(3)(a), a petition to withdraw finality is decided by the Technology Center Director.

STATEMENT OF FACTS

A non-final office action was mailed on 10/06/2006 rejecting claim 3 under 35 U.S.C. § 112, second paragraph and rejecting all claims over prior art references Watanabe, Gardner, Katayama, and Watanabe 487. Applicants responded on 01/05/2007 by amending claim 3 to overcome the 112 rejection and providing arguments over the prior art. Claim 3 was amended in two ways. First, the claim dependency was changed from “claim 0” to “claim 2.” In the office action of 10/06/2006, the Examiner acknowledged a belief that “claim 2” would be correct (p. 2, lines 12-13). Second, the claim was amended to change “less than about 30% platinum by weight” to “platinum in an amount greater than 0 to about 30 percent by weight” as specifically suggested by the Examiner (p. 3, lines 16-17). The Examiner stated that the original claim was unclear as to whether values that were both greater than 30 and about 30 were included (p.3, lines 15-16). Applicants made no admission of this contention.

On 03/23/2007, a final office action was mailed, which included two new grounds of rejection of claim 3 over Watanabe in view of Katayama and Watanabe in view of Gardner. Katayama was cited for disclosing up to 16 atom% platinum (p. 5, line 5). The Examiner affirmatively stated that applicants' amendment necessitated the new grounds of the rejection and accordingly made the rejection final (p. 7, lines 2-3).

ARGUMENT

Under MPEP 706.07(a), "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement." No IDS was filed with the previous amendment.

The amendment to claim 3 was of a trivial nature, the effect of which, if any, was only for values near 30%. The new grounds of rejection cite only prior art references that had been cited in the earlier non-final rejection. The amendment did not necessitate the new grounds of rejection, and the rejection should not be a final rejection.

Therefore, Applicants respectfully request that the finality of the office action be withdrawn.

37 CFR § 1.181 does not specify a fee for this petition. However, in the event that a fee is required, please charge the fee to Deposit Account No. 50-0281, and in the event that there is a credit due, please credit Deposit Account No. 50-0281.

Respectfully submitted,



Joseph T. Grunkemeyer
Reg. No. 46,746
Phone No. 202-404-1556
Office of the Associate Counsel
(Patents), Code 1008.2
Naval Research Laboratory
4555 Overlook Ave, SW
Washington, DC 20375-5325